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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,685	12/08/2000	Rebecca M. Cade	A-31089A	2712

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/733,685	CADE ET AL.	
	Examiner	Art Unit	
	Anne R. Kubelik	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,6-13 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,6-13 and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The claims have been amended as requested in Paper No. 7, filed 21 April 2003 have been entered. Claims 14-20, which the amendment indicates as being withdrawn, were cancelled in the amendment filed 26 September 2002. Claims 2-3, 6-13 and 21-28 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The abstract is not descriptive of the instant invention, which is the NI16 gene from Arabidopsis, not the potato and tomato homologues. A new abstract is required that is clearly indicative of the invention to which the claims are directed. The abstract of the disclosure should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
4. The title of the invention is not descriptive of the instant invention, as above. A new title is required that is clearly indicative of the invention to which the claims are directed. Note that titles can be up to 500 characters long.

Response to Arguments

5. The rejection of claims 1, 4-5, 6-12 and 21-28 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn on light of Applicant's arguments.

Response to Amendment

6. The objection to claims 3, 9 and 24 is WITHDRAWN in light of amendment to the claims.

Claim Rejections - 35 USC § 112

7. Claims 3, 12 and 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections. The rejection is modified from the rejection set forth in the Office action mailed 5 December 2002, as applied to claims 12-13 and 27-28, and for the new reasons below. Applicant's arguments filed 21 April 2003 have been fully considered but they are not persuasive.

It is not clear in claims 12 and 27 if the transgenic seed comprises the chimeric gene of the instant invention or if they are transformed with some other nucleic acid.

Applicant urges that because the seed is transgenic it would comprise the nucleic acid molecule of claim 2 (response pg 9-10).

This is not found persuasive because the seed may be transgenic because it has been transformed with some other nucleic acid. It is suggested that the claim be amended to insert --, wherein the seed comprises the chimeric gene-- before the period.

Claim 3 is indefinite in its recitation of "the coding region of SEQ ID NO:1" in line . because any DNA has 6 potential readings frames each comprising at least one open reading frame, it is unclear which coding region of SEQ ID NO:1 is being referred to.

8. Claims 2-3, 6-12 and 21-28 are free of the prior art, given the failure of the prior art to teach or suggest an isolated nucleic acid encoding SEQ ID NO:2.

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Conclusion

9. No claim is allowed.

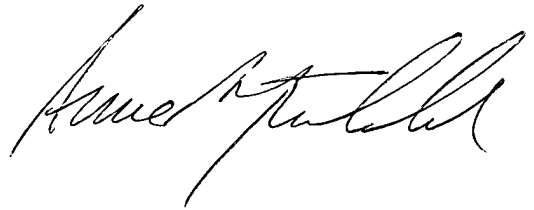
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 308-0198.

Anne R. Kubelik, Ph.D.

June 26, 2003

A handwritten signature in black ink, appearing to read "Anne R. Kubelik", is located in the lower right portion of the page.